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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/381,794	12/27/1999	JAMES S. HUNTER	454313-2540	4437

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FROMMER LAWRENCE & HAUG  
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NEW YORK, NY 10151

EXAMINER

LEVY, NEIL S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 03/05/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

091/ 381794

Applicant(s)

HUNTER et al

Examiner

MIL Guy

Group Art Unit

16/16 19

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- ☒ Responsive to communication(s) filed on 12/16/02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

**Disposition of Claims**

- ☒ Claim(s) 22-49 is/are pending in the application.
- Of the above claim(s) 24-27, 29, 30, 37, 44-47 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 22, 23, 28, 31-36, 38-43, 48 & 49 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 22-49 are subject to restriction or election requirement.

**Application Papers**

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

\*Certified copies not received: \_\_\_\_\_

**Attachment(s)**

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

**Office Action Summary**

Applicant's election with traverse of group I species fipronil in Paper No. 1 is acknowledged. The traversal is on the ground(s) that there is no undue burden to search both group and additional species. This is not found persuasive because PTO requires quality searching, thus, a serious burden exists, and the comprehensive searches required would need to be done over and above the expected time frame of the normal workload. The fact that some of each can be expected to be found in a search for the other, does not imply a comprehensive search has been done, but rather the general concept was well known in the art.

The requirement is still deemed proper and is therefore made FINAL.

Claims 24-27, 29, 30, 37 and 44-47 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions and species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 17.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Please provide an abstract.

Claims 22, 23, 28, 31-34, 38-43, 48 and 49 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The rejection of record is maintained; efficacy is only disclosed for fipronic (p.2); the other compounds are presumed, but not shown, to be effective, and for over 2 months, in dogs.

Claims 22, 23, 28, 31-36, 38, 39, 43, 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper et al '96 and Frontline Top spot ok Meo et al '96 and Mizutani et al WO-9616544 and Dryden et al '94.

Cooper shows application of the instant compound, as supplied by manufacturer for flea control, provides eradication of Lice, without further environmental treatment. Fipronic was chosen due to its long residual activity against fleas. The product used was in accord with manufacturer recommendation; thus, the spot on formulation as instantly claimed (top spot) Dryden (p.12) states if adults are kept from reproducing control can be obtained. The cited references show the required continued control. Meo also shows use of Fipronic at the instant concentration, controlled or eliminated flea in the premises of dogs and cats.

Mizutani shows the instant crystallization inhibitors (claim 11).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made desiring to utilize insecticidal protection of dwellings, to use topical application of Frontline/ Fipronic, in order to control fleas, with expectation of control of fleas on premises of dogs and cats.

It has not clearly been established by objective showing of some unobvious and/or unexpected results that the administration of the particular form of active, carrier, or the particular Locus to be treated provides any greater level of prior art expectation as claimed. Further, no critically as to the ingredient actives, concentrations, ratios form or Application has been shown by applicant.

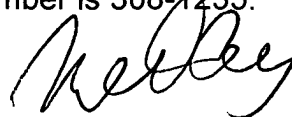
The selection of each ingredient and form thereof is a result effective parameter chosen to obtain the desired effects. It would be obvious to vary the nature of each ingredients to optimize the effects desired, and the use ingredients for the functionality for which they are known to be used is not a basis for patentability.

Applicant's arguments filed 7/23/02 have been fully considered but they are not persuasive. Applicants' arguments have been considered, but it is clear the prior art knew Fipronic would eradicate fleas from dog and cat premises, if the fleas could be eradicated throughout their life cycle to prevent flea adult reproduction. Fipronic is shown to have a sufficient duration of action, if applied monthly, as shown by Meo, and Cooper. Applicants arguments, however, are persuasive as to the 102 rejections, withdrawn. It is agreed it would not be known that application of a specific toxicant to a specific animal would necessarily control, to say nothing of eradicate, a specific pest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is 308-2412. The examiner can normally be reached on Tuesday- Friday 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are 308-4556 for regular communications and 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1235.

  
NEIL S. LEVY  
PRIMARY EXAMINER